

REMARKS

Upon entry of the present amendment, claim 1 will have been amended to correct informalities in the claim language and to more clearly define the invention, while not substantially affecting or narrowing the scope of the claims and claim 8 has been previously canceled. Applicant respectfully submits that all pending claims are now in condition for allowance.

In the outstanding Office Action, the Examiner had rejected claims 1-7 under 35 U.S.C. § 112, first paragraph, asserting that the specification does not reasonably provide enablement for several enumerated recitations of claim 1. Applicant respectfully traverses and submits that at least based on the claim amendment, the specification is sufficiently enabling with respect to the subject matter of all of the claims.

In response, Applicant notes that during the interview of March 23, 2004, discussed in the response of April 21, 2004, the Examiner indicated that the claimed "return-address-setter" should be limited to the additional program aspect of the invention in the second paragraph of claim 1. He furthermore indicated that this would overcome the 35 U.S.C. § 112, first paragraph rejection. Subsequent to the interview, Applicants representative discussed some alternative language with the Examiner. This alternative language was utilized in the April 21, 2004 response. By the present response Applicants amend the claims to include the language that the Examiner had initially indicated would overcome the 35 U.S.C. § 112, first paragraph rejection and Applicants have deleted the later discussed alternative language.

It thus is respectfully asserted that the specification does contain a written description of the invention, and of the manner and process of making and using it, in

such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. Applicant submits that there is specific structure described in the specification and the figures to allow one of ordinary skill to make and use the invention as it relates to the *return-address-setter*, as claimed.

The Examiner has also rejected claims 1-7 under 35 U.S.C. § 112, first paragraph, because claim 1 contains subject matter which was not described in the specification.

The Examiner points to the language at lines 25-26 that was added in the amendment of April 21, 2004. While Applicants do not agree that this language was not described in the specification such that it should be rejected under 35 U.S.C. § 112, first paragraph, in order to expedite prosecution in the present application, Applicants have deleted this language from claim 1 as noted above.

Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 112, first paragraph.

The Examiner has rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,237,120 to SHIMADA in view of U.S. Patent No. 4,831,517 to CROUSE. Applicants respectfully traverse the rejection and assert that it is inappropriate.

In the present disclosed invention, inter alia, a RAM stores a revisional program that is executed when there is a coincidence between a program counter address and an address of at least one comparison address storage device. After execution of the revisional program, the return address is set with a return-address-setter and then an

address-coincidence-disabler disables further coincidence, and thus avoids an interruption, to continue executing the ROM programs.

SHIMADA is directed to a program for patching of a ROM. In particular, a correcting content of a program is executed at step ST7 during an interruption. Then SHIMADA returns from the interruption and abolishes the return address at ST8 and a jump instruction is executed at step ST9 to skip a defective portion of the ROM (See column 5, lines 10-27).

Thus, SHIMADA does not disclose, inter alia, a return address setter that sets a return address that coincides with the comparison address data and does not return the address at least because the address is abolished. Additionally, SHIMADA does not disclose an address-coincidence-disabler because SHIMADA merely jumps to another portion of the program and has no need to disable in the manner recited in claim 1.

CROUSE discloses an insertion point 36 that executes additional code 38. After the additional code is executed, a RWM branch instruction 39 provides an address for a ROM instruction immediately after insertion point 36.

In this regard, CROUSE does not disclose a return-address-setter that sets an address to coincide with the comparison address data. Instead, CROUSE stores an instruction for a subsequent address. Additionally, CROUSE does not have an address-coincidence-disabler because CROUSE jumps to a subsequent address and thus also has no need to disable, as recited in claim 1.

Moreover, there is no suggestion or disclosure in SHIMADA or CROUSE separately or in any proper combination that render obvious the features of the present

claimed invention that include the return address-setter and the address-coincidence-disabler.

With regard to claims 2-7, Applicant asserts that they are allowable at least because they depend from independent claim 1, which Applicant submits has been shown to be allowable.

In view of the herein contained amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of previously asserted rejection set forth in the Official Action, together with an indication of the allowability of all pending claims, in due course. Such action is respectfully requested and is believed to be appropriate and proper.

Pursuant to MPEP §714.13, Applicants contend that entry of the present amendment is appropriate because the proposed amended claims avoid the rejections set forth in the last Office Action, resulting in the application being placed in condition for allowance, or, alternatively, the revised claims place the application in better condition for purposes of appeal. Furthermore, the revised claims do not present any new issues that would require any further consideration and/or search by the Examiner. In particular, the present claim amendment was discussed before the previous response during the interview of March 23, 2004. The Examiner indicated that this amendment would overcome the 35 U.S.C. § 112, first paragraph rejection. Additionally, the amendment does not present any additional claims without canceling a like number of pending claims. Accordingly, entry of the present amendment is respectfully requested.

Applicant has made a sincere effort to place the present application in condition for allowance and believe that he has now done so. In this regard, Applicant has pointed

out specific language of Applicant's specification that provides a written description of the recited claims and respectfully requests an indication to such effect, in due course.

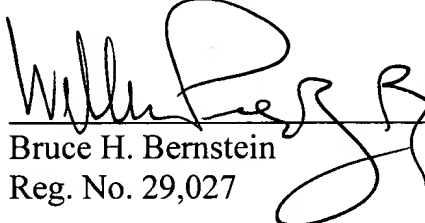
SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believe that he has now done so. Applicant has pointed out the specific language of Applicant's claims that define over the references of record and respectfully request an indication to such effect, in due course.

The amendments to the claims made in this amendment have not been made to overcome the prior art, and thus, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions concerning this Reply or the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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